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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/007,266	12/03/2001	James Conlow	1980.001.US	2588
23661 7590 01/29/2007 BEESON SKINNER BEVERLY LLP ONE KAISER PLAZA, SUITE 750 OAKLAND, CA 94612			EXAMINER GREIMEL, JOCELYN	
			ART UNIT 3693	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE			MAIL DATE	DELIVERY MODE
3 MONTHS			01/29/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.		Applicant(s)	
	10/007,266		CONLOW, JAMES	
	Examiner		Art Unit	
	Jocelyn Greimel		3693	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-80 and 88-91 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-80 and 88-91 is/are rejected.
- 7) ☒ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>02/13/02</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is in response to Applicant's application of 03 December 2001, which claims the benefit of 60/250,814 filed on 01 December 2000. In response to the Restriction Requirement, Applicant elected claims 1-80 and 88-91 on 24 November 2006. Claims 1-80 and 88-91 are currently pending and are presented to be examined upon their merits. Claims 1, 48 and 88 are independent claims.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

3. Claims 1, 48 and 88 and their related dependent claims are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In reference to these claims, Applicant uses the phrase: "related by a common business interest" – does this mean the entities are all part of the construction industry or does it mean they are all part of certain company, such as ABC Corporation? Additionally, Applicant uses the phrase: "in contractual relation with a hiring entity in a superior tier" - which is unclear. The Specification describes the "hierarchical business organization" and the "tiers of entities" – however, these items are claimed broadly within the claim language.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. **Claims 1-11, 13, 15-17, 27, 31-47, 49-87 and 89-91 are rejected under 35 U.S.C. 102(b) as being anticipated by Kolling et al (US Patent No. 5,920,847, hereinafter Kolling).** In reference to claims 1, 48 and 88 and the related dependent claims, Kolling discloses a method, system and apparatus for bill presentment and payment comprising:

a. a hierarchical business organization having a plurality of tiers of entities, said entities related by a common business interest, said hierarchical business organization further including at least two tiers each having at least one billing entity, each said billing entity in contractual relation with a hiring entity in a superior tier of said business organization, said hierarchical business organization further including a first tier having at least one paying entity (col. 4, line 18 – col. 7, line 7);

- b. one or more memories for storing entity information on each of said entities of said hierarchical business organization (col. 28, line 5 – col. 30, line 6; Fig. 11);
 - c. one or more network interfaces for sending and receiving data to and from billing entity nodes and paying entity nodes (col. 28, line 5 – col. 30, line 6; Fig. 11);
 - d. one or more processors in communication with said one or more memories (col. 28, line 5 – col. 30, line 6; Fig. 11);
 - e. wherein, when said one or more network interfaces receives billing data for a billing entity from one of said billing entity nodes, said one or more processors prepares a bill for said billing entity based on said billing data, said bill for transmission to a paying entity node (col. 28, line 5 – col. 30, line 6; Fig. 11).
6. In reference to dependent claims 2-47, 49-80 and 89-91, Kolling discloses a method, system and apparatus for bill presentment and payment including memories, processors, printers, data storage, entity nodes, network interfaces for:
- f. project information (col. 11, line 4 – col. 12, line 19);
 - g. entity information (col. 11, line 4 – col. 12, line 19);

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- h. bills based on entity information (col. 11, line 4 – col. 12, line 19);
- i. remittance instructions (col. 15 – col. 17);
- j. listings of payments (col. 11, line 4 – col. 12, line 19);
- k. verification of billing data (col. 15 – col. 17);
- l. lists of tasks for each billing entity (col. 11, line 4 – col. 12, line 19);
- m. retention amounts (col. 15 – col. 17);
- n. bills including entity tasks (col. 11, line 4 – col. 12, line 19);
- o. stored costs (col. 11, line 4 – col. 12, line 19);
- p. verification of costs and tasks (col. 15 – col. 17);
- q. making payments and printing checks (col. 15 – col. 17);
- r. checking billing status (col. 15 – col. 17);
- s. payments made by a bank for an entity (col. 15 – col. 17).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. **Claims 12, 14, 18-22, 26, 28-30 and 32-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kolling in view of Official Notice.** In reference to claims 12, 14, 26, 28-30 and 32-33, Kolling teaches the bill presentment and payment systems detailed above. Kolling fails to teach a bill presentment and payment method, system and apparatus including:

- t. application of discounts
- u. identification of duplicates;
- v. creating approval and correction reports; and
- w. claims release.

The Examiner takes official notice that the tasks of application of discounts, identification of duplicates, creation of approval/correction reports and claims release forms are old and well-known in the financial arts. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the bill presentment and payment method of Kolling to include the application of discounts, identification of duplicates, creation of approval/correction reports and claims

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release forms because these features would create an efficient and thorough billing system.

10. Claims 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kolling. In reference to claims 23-25, Kolling teaches a bill presentment and payment system as detailed above using various groups and the data related to these groups including:

- x. business groups
- y. billing entities
- z. paying entities
- aa. authorization entities (col. 11, line 4 – col. 12, line 19).

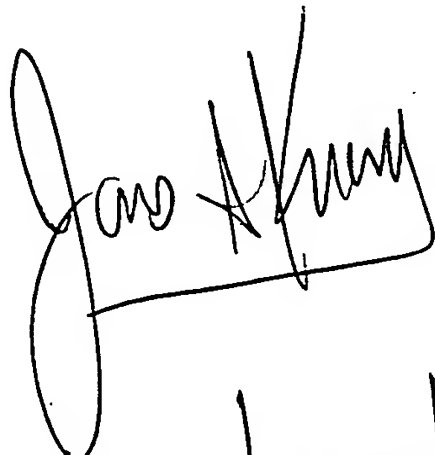
Kolling teaches the bill presentment and payment systems detailed above including various groups engaged in the bill presentment and payment. Kolling does not explicitly teach first tier groups comprising: construction project owners, building contractors and financial institutions. The Examiner takes official notice that construction project owners, building contractors and financial institutions are specific entities of the groups disclosed by Kolling. The name or type of entity does not functionally affect the bill presentment or payment system and is a design choice of the bill producer. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the entities to include such groups as construction project owners, building contractors and financial institutions because it would make the bill presentment more clear and efficient for the bill producer and receiver.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jocelyn Greimel whose telephone number is (571) 272-3734. The examiner can normally be reached on Monday - Friday 8:30 AM - 4:30 PM EST. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on (571) 272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jocelyn Greimel
Examiner, Art Unit 3693
January 19, 2007


JAMES KRAMER
1/23/07